

MANUAL OF PATENT EXAMINING PROCEDURE (MPEP)

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809.03

MANUAL OF PATENT EXAMINING PROCEDURE

The treatment of the application should be as indicated in MPEP § 809.02(b), § 809.02(c), or § 809.02(d).

809.03 Linking Claims

There are a number of situations which arise in which an application has claims to two or more properly divisible inventions, so that a requirement to restrict the application to one would be proper, but presented in the same case are one or more claims (generally called "linking" claims) inseparable therefrom and thus linking together the inventions otherwise divisible.

The most common types of linking claims which, if allowed, act to prevent restriction between inventions that can otherwise be shown to be divisible, are

- (A) genus claims linking species claims;
- (B) a claim to the necessary process of making a product linking proper process and product claims;
- (C) a claim to "means" for practicing a process linking proper apparatus and process claims; and
- (D) a claim to the product linking a process of making and a use (process of using).

Where linking claims exist, a letter including a restriction requirement only or a telephoned requirement to restrict (the latter being encouraged) will be effected, specifying which claims are considered to be linking. Examiners should use Form Paragraph 8.12 to make restrictions involving linking claims.

§ 8.12 Restriction, Linking Claims

Claim [1] link(s) inventions [2] and [3]. The restriction requirement [4] the linked inventions is subject to the nonallowance of the linking claim(s), claim [5]. Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

Examiner Note:

1. This form paragraph must be included in any restriction requirement with at least one linking claim present.

2. In bracket 4, insert either --between-- or --among--.
3. In bracket 5, insert the claim number(s) of the linking claims.
4. See related form paragraphs 8.45, 8.46 and 8.47.

For traverse of rejection of linking claim in applications, see MPEP § 818.03(d).

809.04 Retention of Claims to Non-elected Invention

Where the requirement for restriction in an application is predicated upon the nonallowability of generic or other type of linking claims, applicant is entitled to retain in the case claims to the nonelected invention or inventions.

If a linking claim is allowed, the examiner must thereafter examine species if the linking claim is generic thereto, or he or she must examine the claims to the nonelected inventions that are linked to the elected invention by such allowed linking claim.

Form paragraph 8.45 should be used to notify applicant of the allowance of a linking claim and that the nonelected claim(s) depending from or including all the limitations of the allowable linking claim, previously withdrawn from consideration, is/are rejoined and fully examined for patentability under 37 CFR 1.104.

§ 8.45 Allowance of Linking Claim(s), Nonelected Claims Not Canceled

Linking claim [1] allowed. Since the restriction requirement [2] inventions [3], as set forth in Paper No. [4] mailed on [5], was conditioned on the nonallowance of the linking claim(s), the restriction requirement as to the linked inventions is hereby withdrawn. Claim [6], previously withdrawn from consideration as a result of the restriction requirement, [7] hereby rejoined and fully examined for patentability under 37 CFR 1.104. In view of the withdrawal of the restriction requirement as to the linked inventions, applicant(s) are advised that if any claim(s) depending from or including all the limitations of the allowable linking claim(s) be presented in a continuation or divisional application, such claims may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Once the restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

Examiner Note:

1. This form paragraph must be used upon the allowance of a linking claim following a restriction requirement with at least one linking claim present and wherein the nonelected claims have NOT been canceled. Use form paragraph 8.46 where the nonelected claims HAVE BEEN canceled.

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